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EXAMINER

BELL, KENT L

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 15

Application Number: 09/733,016

Filing Date: December 8, 2000

Appellant(s): Andrea Michalik

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Russell D. Orkin

For Appellants

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed March 4, 2003.

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**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interference***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or having a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

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**(6) Issues**

The appellant's statement of the issues in the brief is correct.

**(7) Grouping of Claims**

There is only a single claim.

**(8) Claims Appealed**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

- 1) QZ PBR 980251, filed February 25, 1998 which was published April 15, 1998.
- 2) PL PBR PBO0050, application filing number OO00504, filed January 12, 1999 which was published March 31, 1999.
- 3) CZ PBR OPPH06594, application filing number 1084, filed August 16, 1999 which was published October 1, 1999.
- 4) ZA PBR 02603, application filing number PT 2603, filed September 28, 1998 which was published September 28, 1998.

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5) Cooper, "Biotechnology and the Law", Section 8.05, pages 8-15 to 8-16

(August 2000), Clark, Boardman, Callaghan.

**(10) *Grounds of Rejection***

The following ground(s) of rejection is/are applicable to the appealed claims:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless--

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 (The Claim) is rejected under 35 U.S.C. 102(b) as being anticipated by Plant Breeder's Right application number 980251 (European Union) in view of appellant's admission that 'Pennea' was "sold outside the United States on or about July 1, 1998" (Page 2 of response filed January 23, 2002).

The European application number 980251 was published April 15, 1998. The published European application is a "printed publication" under 35 U.S.C. 102 because it is accessible to

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persons concerned with the art to which the document relates. See *In re Wyer*, 655 F.2d 221, 226, 210 USPQ 790, 794 (CCPA 1981). See also MPEP § 2128. Copies of The European application (980251) are obtainable through the European Communities Register of Applications for Community Plant Variety Rights. This register is open to public inspection and the information in this register is published every two months in an Official Gazette. This Official Gazette contains information appearing in the Register such as applications for protection, proposals for variety denomination and grants of title. Other information the Community Plant Variety feels important to the public may also be published in the Gazette.

Thus information regarding the claimed variety, in the form of the publication noted above, was readily available to interested persons of ordinary skill in the art. A publication relied upon as prior art under 35 USC 102(b) must be enabling. The text of the relied upon publication standing alone would not enable one skilled in the art to practice the claimed invention. However, when the claimed subject matter is disclosed identically by a reference, an additional reference may be relied on to show the primary reference has an "enabled disclosure". *In re Samour*, 571 F.2d 559, 197 USPQ 1 (CCPA 1978) and *In re Donohue*, 766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985). See also MPEP § 2131.01. When the claim is drawn to a plant, the reference, combined with knowledge in the prior art, would enable one of ordinary skill in the art to

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reproduce the claimed plant. *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). Where one skilled in the art reproduces the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ 2d 1618, 1620, (Bd. Pat. App. & Inter. 1992) (“The issue is not whether the [claimed] cultivar Siokra was on public use or sale in the United States but, rather, whether Siokra seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the Siokra cultivar disclosed in the cited publications.”). See also MPEP § 2121.03.

Appellant admits on page 2 of the response filed January 23, 2002 that the cultivar ‘Pennea’ was sold outside the United States on or about July 1, 1998. This constitutes evidence that the claimed cultivar was available to the public more than one year before the present application’s United States filing date. The Plant Breeder’s Right application filing number 980251 is enabled because the disclosed cultivar could have been propagated from publicly available materials, and one skilled in the art would have the knowledge of how to do so, given the notoriety of various methods of asexual propagation. See, e.g., *Thomson, supra*. See also Cooper, Biotechnology and the Law § 8.05 (1998 Clark Boardman Callaghan). “In essence then, a plant patent appellant cannot lose his rights through public description of the new variety so long as he does not make the stock available for propagation by the public.”.

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The Claim is rejected under 35 U.S.C. 102(b) as being anticipated by Plant Breeder's right application number OO00504 (Poland), published March 31, 1999, in view of appellant's admission that 'Pennea' was "sold outside the United States on or about July 1, 1998" (Page 2 of response filed January 23, 2002), for the reasons discussed above.

The Claim is rejected under 35 U.S.C. 102(b) as being anticipated by Plant Breeder's right application number 1084 (Czech Republic), published October 1, 1999, in view of appellant's admission that 'Pennea' was "sold outside the United States on or about July 1, 1998" (Page 2 of response filed January 23, 2002), for the reasons discussed above.

The Claim is rejected under 35 U.S.C. 102(b) as being anticipated by Plant Breeder's right application number PT 2603 (South Africa), published September 28, 1998, in view of appellant's admission that 'Pennea' was "sold outside the United States on or about July 1, 1998" (Page 2 of response filed January 23, 2002), for the reasons discussed above.

**(11) *Response to Arguments***

Appellant argues that an anticipation rejection cannot be built from multiple references. Additionally, Appellant argues that the PBR application does not disclose every material element of the claim and the rejection attempts to circumvent 35 U.S.C. § 102(b) by relying on sale outside of the U.S. more than one year prior to filing patent application in the United States.



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Appellant further argues that Application of *In re Samour*, 571 F.2d 559, 197 USPQ1 (CCPA 1978) and *In re Donohue*, 766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985) is incorrect and not supported by case law, and that neither case stands for the proposition that an additional reference may be used to supplement a non-enabling disclosure of a primary reference.

Appellant further argues that *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962) and *Ex parte Thomson*, 24 USPQ2d 1618 (Bd. Pat. App. & Inter. 1992) are consistent with *Samour*, *Donohue*, and *Bristol-Myers* and do not support a proposition that a non-enabling publication about a plant may be made enabling by public use or sale of the plant itself. Finally, Appellant argues that enablement of a PBR publication as a prior art reference is inconsistent with past and current examination practices in plant patent applications.

The Examiner generally agrees with the Appellant as to the interpretation of *In re Samour* and *In re Donohue*, however the Examiner would like to point out that the admission of Appellant that the plant was for sale more than one year prior to application for U.S. patent is not “supplementing” the primary reference, rather the sale of the plant provides proof that the primary reference was enabling. The Examiner would like to point out how the two cited cases support the rejection that was made under 102(b). As noted in *In re Samour*,

“a printed publication which discloses every material element of the claimed subject matter, would constitute a bar under 35 USC 102(b) to appellant’s right to a patent if, more than one year prior to appellant’s filing date, it placed [the claimed subject matter] ‘in possession of the public’. Whether claimed subject matter was in possession of the public depends on whether a method of preparing the claimed subject matter would have

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been known by, or would have been obvious to, one of ordinary skill in the pertinent art.” 197 USPQ at 3-4 (citations omitted).

The court noted that a printed publication that places the invention in possession of the public would constitute a bar under 35 USC 102(b). This language is also used in LeGrice as is discussed in further detail below. A printed publication identifying the breeder and assignee of a particular plant in combination with the public availability of the plant places the plant in the public’s possession. At page 4, paragraph 2 of the Brief, Appellant admits that the invention was “in the possession of the public”.

The court further noted that the disclosure in the primary reference must be considered together with the knowledge of one of ordinary skill in the pertinent art, and that it is appropriate to rely on additional references solely as evidence that, more than one year prior to appellant's filing date, a method of preparing the claimed subject matter would have been known by, or would have been obvious to, one of ordinary skill in the art. 197 USPQ at 4.

As noted by appellant, *In re Donohue* stands for the propositions that disclosure of a claimed invention in a printed publication will not suffice as prior art if it is not enabling, and that prior art under 35 USC 102(b) must sufficiently describe the claimed invention to have placed the public in possession of it. “Such possession is effected if one of ordinary skill in the art could have combined the publication’s description of the invention with his own knowledge to make the claimed invention.” 226 USPQ at 621.

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The Examiner understands that the primary contention of the Appellant is that not every material element is disclosed in the primary reference. However, here, as in *Donohue*, the invention described in the primary reference is identical to the claimed invention. If the reference teaches the invention but does not teach every single inherent property of the invention, it still anticipates the claim. As explained in *Donohue*:

“Appellant also argues that the references fail to teach the solubility characteristics and melting point range set forth in dependent claims 25 and 28, respectively. However, where as here, the dicarboxylic acid TMBP and dimethyl ester TMBP of Nomura are identical to the claimed invention, the properties of Nomura’s compounds are inherently the same as those of the claimed invention in the absence of proof to the contrary. See *In re Best*, 562 F.2d 1252, 195 USPQ 430, 433-34 (CCPA 1977).” 226 USPQ at 622.

The claim in a plant patent application is drawn to a “plant” as described and illustrated in the specification, i.e., the claim is drawn to a plant with certain inherent characteristics. The cited Plant Breeders’ Rights (PBR) document which serves as the anticipatory reference is drawn to the exact same plant as claimed. As a result, the PBR publication teaches each material element of the claim even if the disclosure is not as detailed as an application for plant patent.

As a result, contrary to Appellant’s assertions, *In re Samour* and *In re Donohue* support the rejection under 35 USC 102(b). The primary reference teaches every material element of the instant invention. Appellant has not pointed out how their admission that the plant was for sale constitutes a “secondary reference.” The admission of sale is used to show that the PBR publication was enabling. Even if this admission were to constitute a secondary reference, Appellant has not pointed out any “additional disclosure” it contains that is not part of the primary

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reference. The only reliance on the “secondary reference” (Appellant’s admission that the claimed subject matter was sold more than one year prior to the U.S. filing date) was to show that the claimed subject matter was in the public possession more than one year prior to the filing date of the patent application.

Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc. et al., 246 F.3rd 1368, 58 USPQ2d 1508 (Fed. Cir. 2001) as presented by the Appellant, does not have any additional bearing on this case as it concurs with both *In re Samour* and *In re Donohue*.

The Examiner notes and agrees with appellant’s statements that *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962) and *Ex parte Thomson*, 24 USPQ2d 1618 (Bd. Pat. App. & Inter. 1992) are consistent with *Samour*, *Donohue* and *Bristol-Myers*.

The Examiner’s position is not inconsistent with either *In re LeGrice* or *Ex parte Thomson*. In *LeGrice*, the court held that in order for a printed publication to be a statutory bar under 35 USC 102(b), the publication must provide an enabling disclosure. In the words of the court,

“before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention.” 133 USPQ at 372 (emphasis in original).

The court then states that plant publications should not be totally ignored as printed publications; rather the fact that a printed publication must be enabling “requires that the facts of

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each case be carefully considered to determine whether the description in a the printed publication in question *does in fact* place the invention in the possession of the public” 133 USPQ at 374.

In summarizing the long recognized requirements of a prior publication, the court quotes Robinson on Patents, Sec. 325 as follows:

[To have the effect of a prior publication,] the publication must be: (1) A work of public character, intended for general use; (2) Within reach of the public; (3) Published before the date of the later invention; (4) A description of the same complete and operative art or instrument; and (5) So precise and so particular that any person skilled in the art to which the invention belongs can construct and operate it without experiments and without further exercise of inventive skill. Unless a publication possesses all these characteristics it does not place the invention in the possession of the public.

133 USPQ at 369.

The PBR document that is relied upon by the Examiner is a publication that meets each of these criteria. The application and granting of Plant Breeders' Rights is carried out in a public forum and can be easily accessed through the Internet, CD-ROM, and direct publication by governmental offices in each of the countries that adhere to The International Union for the Protection of New Varieties of Plants, or UPOV (Union Internationale pour la Protection des Obtentions Végétales). The cited PBR document was published more than one year prior to filing in the United States. The citation is drawn to the same plant for which patent was filed. Lastly, the PBR document precisely refers to the species of plant and the name of the plant. Since this plant was sold more than one year prior to the effective filing date of the present application, one

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skilled in the art would have been able to purchase and propagate the plant “without experiments or further inventive skill”. One of even ordinary skill in the art would have been able to reproduce the plant asexually and grow it without experimenting further with the plant in order to obtain the claimed invention. By using the referenced publication, one of skill in the art would have been able to contact the Appellant, Breeder, and Title Holder of the plant in question (information included on the referenced publication) and subsequently obtain a plant since it was being marketed by Appellant’s own admission. Such a plant would thus have been in the public possession due to information in the publication.

It is generally recognized that *prior public use and sale of a plant are the avenues by which a plant enters the public domain*. See, e.g., *LeGrice*, 133 USPQ at 370-71. The Examiner agrees with Appellant that the PBR publication by itself would not be an enabled publication, were the plant not in the public domain. However, the PBR publication when considered in combination with the knowledge of one skilled in the art, i.e., the availability of the plant in the public domain as evidenced by sale of the claimed plant more than one year prior to application for patent, places the plant in the public domain, and therefore is enabled since one skilled in the art would have been able to reproduce that exact same plant through asexual means. It is noted that Appellant has not provided any evidence that one skilled in the art would know

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how to propagate a geranium. *LeGrice* ruled that a publication alone was not enough to put a plant in the public domain. The fact scenario of this rejection does not parallel the facts in the *LeGrice* case because the rejection here is not based on a publication alone. Indeed, *LeGrice* makes it very clear that "Prior public use and sale of a plant are the avenues by which a plant enters the public domain." The PBR publication, together with public availability of the plant, would have allowed a skilled artisan to take the teachings of the cited PBR and combine them with his own knowledge of the art to be in possession of the invention.

Dr. Richard Craig's declaration has been reviewed. The Examiner agrees with Dr. Craig that it is practically impossible to generate the claimed plant from a description thereof in a printed publication, since it is a product of a cross-fertilization of heterozygous parents. However, the rejection is not based on one of skill in the art being able to reproduce a particular plant from a description or a drawing. The rejection is based on the fact that a skilled artisan could take the teachings of the cited PBR document and *in combination with his or her own knowledge of the particular art be in possession of the invention* due to the fact that the instant plant was sold more than one year prior to the filing date of the U.S. application. As explained above, the publication in light of the fact that the instant plant was sold, put the plant in the public domain more than one year prior to the US filing.

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Additionally, the Craig declaration does **not** show that the *Thomson* Board was incorrect in concluding that one could buy seeds and obtain the claimed plant. The Examiner is not suggesting that the instant plant can be obtained from the PBR description. Neither did the *Thomson* Board suggest that the plant could be obtained solely from the publication. In both the instant rejection as well as in the *Thomson* case, the public availability is recited as “enabling” the publications. In other words, the teachings of the publications in combination with the knowledge of one of ordinary skill in the art put the invention in the public domain. The Craig declaration does not refute that one of ordinary skill in the art would have been able to reproduce the exact same plant as cited in the PBR documents and as claimed in the application for U.S. patent given the fact that the plant was available to the public more than one year prior to filing.

The Examiner fails to see the validity of the argument presented on page 12 of the Appeal Brief that § 163 does not grant a right to exclude others from “making” a claimed plant but only excludes others from asexually reproducing or selling the claimed plant. In the case of asexually propagated plants, the plant is “made” by asexually propagating plants. This is acknowledged in 35 U.S.C. 112, first paragraph, wherein the “specification shall contain a written description of the invention, and of the manner and process of making...” In the case of plant Patents, the invention is not considered reduced to practice until it has been asexually reproduced and wherein



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the progeny have the exact same characteristics as the parent. The *LeGrice* Court reversed the Board and the Examiner precisely because the cited references did not adequately teach how to make the claimed invention. Therefore, anticipatory prior art must meet the same requirements in plant patents as it does in utility patents. Furthermore, an additional reference used to show that the primary reference put the plant in possession of the public is perfectly appropriate to use in a plant patent application.

Appellant argues that implicit in *LeGrice* is that a publication describing a plant and a source to obtain that plant is not prior art to a plant patent application on that plant. However, this issue was not before the Court in *LeGrice*. There is no discussion in *LeGrice* about enablement of the printed publication on the claimed rose plant based on any other source, such as public availability of the plant. In fact, in *Ex parte Thomson*, page 1621, the Board recognized "...that there is no indication that *LeGrice* had in evidence the facts supporting commercial availability...."

As stated previously, the issue before *LeGrice* was whether a publication needed to be enabling to be considered prior art in a plant case, and as stated previously, the Court decided that the publication presented to them was not enough to put the invention in the public domain. However, public use and sale of a plant does put it in the public domain. The question decided in

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*LeGrice* was, “Do publications have to be enabled to be considered as prior art under 35 USC 102 for plant patents?” The answer was a resounding “Yes!” However, as noted previously, there was no evidence of public availability of the plant described in the reference publication in *LeGrice*, and therefore that issue was not before the court or addressed by the court in its decision.

Appellant argues that the *Le Grice* court had evidence of commercial sale of the claimed plants (Reply Brief, pages 13 and 14). This argument is not persuasive. Contrary to Appellant’s assertion, the facts in the instant case are not identical to those presented in *LeGrice*. The *LeGrice* decision states, “The particular question of law to be here decided is presented on stipulated facts, which, insofar as they relate to the issue, are here quoted from the record...” 133 USPQ at 367. The list of facts that follows does not include the stipulation that the plants sought to be patented were on sale anywhere.

Appellant argues that the *LeGrice* Board of Appeals disposed of the issue of public sale enabling a printed publication. This argument is not persuasive because the Board ruled that the printed publications alone (i.e. without evidence of public availability of the claimed plants) warranted a rejection under 35 U.S.C. 102(b). The question of whether public availability of the plants would “enable” the publications was not considered by the Board or the CCPA.

Moreover, applicant *LeGrice* never stated that the claimed plants were on sale, nor did he provide copies of the catalogue publications (Reply Brief, attachment, page 22, “The catalogues have not been made available”). How could the Board or the CCPA have known the contents of

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publications that were never part of the record? It appears that the Board's conclusion that the plant was on sale and in public use in England had no basis in fact. Naturally, the applicant did not comment on this conclusion because the Board went on to state that it was irrelevant, i.e. not the basis for the rejection (Reply Brief, attachment, page 22, last paragraph). The fact that LeGrice was listed as "distributor" does not itself indicate that the claimed plants had already been distributed to the public, nor would mere display at an exhibition put the public in possession of the claimed plants. In *Ex parte Thomson*, the Board of Appeals concluded that the *LeGrice* case did not have in evidence facts supporting commercial availability of the claimed plants (24 USPQ2d 1618, 1621).

Appellant argues that while public prior use and sale are avenues by which a plant enters the public domain, that prior use or sale must have occurred in the United States to rise to the level of a statutory bar. This argument is not persuasive for two reasons: (1) This issue was not present in *LeGrice*, and (2) This issue is not present in the instant case. The rejection is based on a publication, not prior use or sale. The question then becomes, Is a publication teaching a particular plant enabled if the public has possession of the plant and has the knowledge to make and reproduce that plant?

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In attempting to distinguish the present case from *Ex parte Thomson*, Appellant argues the cited publication contained substantially the same description as the specification and that the publication as well as the specification was enabled by the availability of the claimed seeds.

The Examiner fails to see the distinction between the public availability in *Thomson* as enabling a publication versus the public availability enabling the cited PBR in the present case. There is no dispute in the instant case that the claimed plant and the plant cited in the PBR are the same plant. On the contrary, Appellant has previously admitted that they are the same plant. No amount of descriptive words change the fact that the publication, sale, and specification are all drawn to the exact same plant.

Appellant points out that *Thomson* is directed to a utility application whereas the present application is directed to a plant patent. Appellant argues that a utility claim has a broader scope and the standard for anticipation by a printed publication is to be more broadly applied to the claims in a utility application than to the claim in a plant patent. Appellant further argues the claims must be fully enabled whereas there is no such enablement requirement of a plant patent claim.

*In re LeGrice* as well as 35 USC 161 and 37 CFR 1.161 clearly state that the same laws and rules relating to applications for utility patents also are applicable to patents for plants except for the one exception set forth in 35 USC 162. As a result, the standard for anticipation in a plant patent is the same as the standard for anticipation in a utility patent.

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Appellant argues that every material element of the *Thomson* claim was set forth in the primary reference and that the additional reference was cited solely to show that the plant material was in the public domain. As such, the combining of a PBR application with public availability of a plant under 35 U.S.C. 102(b) is improper in a plant application. Appellant further argues that every material element of the claimed subject matter does not exist in the primary reference of the PBR application, and that the instant plant could not be reproduced from the reference. Appellant argues that this contrasts with *Samour*, *Donohue*, and *Thomson* because the descriptive words of the specification before the Board did not differ substantially from the disclosures of the cited publications. The argument concludes that there is a large difference between the instant specification and the cited PBR documents because the two differ substantially from each other in contrast to the specification and publication discussed in *Ex parte Thomson*. As a result, even if one were somehow capable of overcoming technological barriers and was able to reproduce the plant described in the PBR, numerous plants could meet that description.

This argument has already been discussed above, however, the Examiner would like to additionally point out that in *Ex parte Thomson*, the Board did not state that a full disclosure of the plant was required in the publication. Mere fact of the full disclosure was made to address the question as to whether the references were indeed drawn to the same plant. The *Thomson* decision states, "...we concur with the examiner that the claimed subject matter was described in a printed publication under circumstances whereby it was in the possession of the public more than one year prior to the filing date of the present application." 24 USPQ2d at 1620. The Board

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further states, "Manifestly, it is reasonable to conclude that, at the time the cited articles were published, skilled artisans throughout the world would have found Siokra seeds readily available on the open market." *Id.*

The completeness of the description was not an issue in the *Thomson* case. Rather, it was used to document that there was no disagreement as to whether the claimed plant was a different plant from the plant cited in the reference. The instant case is similar in that there is no disagreement that the PBR publications reference the claimed plant. The fact that the referenced plant is the same as the claimed plant automatically confers that every material element of the claimed subject matter existed in the reference because those characteristics not specifically disclosed are inherent. The issue decided in *Ex parte Thomson* was that if deposit (availability) of the plant enabled the specification, then availability also enabled the publications. It is the availability of the plant cited in *Thomson* that is important, not the description of the plant. In this case, there is no dispute that the PBR publications reference the same plant. Additionally, the availability of the claimed geranium plant enables the cited PBR publications. Based solely on the reference, a skilled artisan would have been able to buy a geranium plant named 'Pennea' which would have been the exact same geranium plant as described in the application for patent. The Examiner readily admits that the plant can not be reproduced from the reference except for the fact that sale of the invention put the invention in the public domain. The Examiner agrees that the PBR publications do not meet the "as complete as is reasonably possible" standards of a US application, but they do contain the **material elements** necessary to put the invention in the public

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domain in light of the fact that the plant was available to the public. Appellant has not pointed out how the admission that the instant plant has been sold makes up for any particular “deficiency” in the cited publication. The rejection is not combining references using motivation, nor is it improperly combining “on sale in the United States” with a publication, rather the sale of the plant is used to show that the publication was “enabled” and that the plant was in possession of the public under 35 U.S.C. 102(b) in keeping with *In re Samour*, *In re Donohue*, *In re LeGrice*, and *Ex parte Thomson*.

A § 102(b) printed publication can be published and enabled anywhere in the world. It does not matter that the plant is available only outside the United States more than one year before the U.S. filing date. The enablement need not occur in the U.S..

Appellant argues that the PBR is an incomplete document, but the Craig declaration says that no amount of description would have been enabling. The plant material must be available for the public to have possession. Appellant admits that the plant material was available. Once a reference teaching a product appearing to be substantially identical is made the basis of a rejection, and the Examiner presents evidence or reasoning tending to show inherency, the burden then shifts to the Appellant to show an unobvious difference (see MPEP 2112). As a result, the appellant needs to prove that the prior art products do not necessarily or inherently possess the characteristics of the claimed product.

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Penultimately, Appellant argues that enablement of a PBR publication as a prior art reference is inconsistent with past and current examination practices. Appellant further argues that "To now assert that a PBR publication somehow is enabling prior art (alone or in combination with sale or use outside the United States) is inconsistent with the examination practice of requiring detailed botanical information in plant patent applications," and that the USPTO cannot have it both ways of asserting a PBR application as enabling prior art and rejecting reasonably detailed plant patent applications for lack of enablement.

A PBR application is enabled as prior art when it sufficiently describes the claimed invention to have placed the public in possession of it. That this is the case in this instance has been argued extensively above. In response to the second part of the argument, the Examiner would like to point out that the Office does not reject plant patent applications for lack of enablement. In fact, it is recognized that the mere description of a plant no matter how detailed it might be does not constitute an enabling description because it does not put the public in possession of the plant. However, if the description in a plant patent application is inadequate, the Examiner rejects the claim under 35 U.S.C. 112, first paragraph, as follows:

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for the reasons set forth in the Objection to the Disclosure Section above.

The claim is rejected on the basis of inadequate description, not "enablement" or "how to make and use". 35 U.S.C., first paragraph requires written description of the invention **and** of the



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manner and process of making and using it. Although Appellants in plant patent applications are relieved of the enablement requirement, they are not relieved of the written description requirement. A better description does not enable a specification, only a deposit or public availability would enable a specification.

Finally, Appellant argues that the current rejection policy is a detriment to the public because plants available in other countries may be withheld from the U.S. market. After careful consideration of this argument, the Examiner declines to comment on this business practice as the issue is not germane to the current rejection.

**Conclusion:**

**Argument:** The PBR applications fail to meet the anticipation requirements of 35 U.S.C. 102(b) and that the sale of the claimed variety outside the United States more than one year prior to the filing date of the U.S. patent application can be relied upon only to show that the claimed subject matter was in the possession of the public and not to supplement the impossibility of the PBRs to disclose every material element of the claimed invention.

**Answer:** Appellant should not confuse the disclosure requirements of 35 USC 162 ("as complete as is reasonably possible") with the "every material element" test of anticipation under 35 USC 102(b). While the PBR information is not "as complete as is reasonably possible" for the standards of a US patent application, every material element of claim 1 is contained therein, i.e.,

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the PBR publication discloses the exact same invention as the application for patent, and there is no evidence of record to the contrary.

The PBR references in this case is supplemented with Appellant's admission that the plant was for sale, thus showing that the plant disclosed in any of the PBRs was in the public domain more than one year prior to filing in the United States. Characteristics of the claimed plant that are not specifically disclosed in the PBRs are inherent properties of the claimed plant.

For the above reasons, it is believed that the rejection should be sustained.

Respectfully submitted,

Kent L. Bell




**KENT BELL**  
**PRIMARY EXAMINER**

May 7, 2003

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